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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,266	06/07/2000	Barry Dworkin	Dworkin.P001	8568

7590 06/04/2003
BARRY DWORKIN
6222 E. TAMARIND ST.
OAK PARK, CA 91377

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/04/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,266

Applicant(s)

DWORKIN, BARRY

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Support of Registered Attorney or Agent

1. While an inventor may prosecute the application, it is the USPTO's experience that lack of prosecution experience usually acts as a liability in affording the maximum protection for the invention disclosed. The Office recommends that applicant consider securing the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution.
2. The following sources are available for selecting an Attorney or agent.
 - (A) Applicant can search the roster of attorneys and agents at the Office's home page, <http://www.uspto.gov>. Click on "Site Index" at the top of the home page. Then, in the alphabetical list, click on "Agent and Attorney Roster". Then click on "Attorney/Agent Search".
 - (B) Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

MPEP

3. All the US patent laws and rules of examination are in the *Manual of Patent Examining Procedure*, 8th edition, which is available through the Office's web site, <http://www.uspto.gov>. Click on "Site Index" at the top of the home page. Then, in the alphabetical list, click on "Manual of Patent Examining Procedure (MPEP) Information Page". The next page gives instructions for viewing individual chapters and parts of the Appendix in .pdf format and for purchasing a paper copy of the MPEP.

Certificate of Mailing

4. It is called to applicant's attention that if a communication is deposited with the U. S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the

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reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
on _____ (date).

Typed or printed name of person signing this certificate

Signature _____

Date _____

Additional useful information on communicating with the Office is contained in an attachment sheet, and in 37 CFR 1.10 (*Patent Rules, Appendix R of the MPEP*).

Information Disclosure Statement

5. The listing of references in the specification, as done on pp. 2-6 of the specification, is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
6. Applicant would have to pay a fee in order to submit an IDS at this "stage 2" of the application process; see MPEP § 609.III.B, *Time for Filing*.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
9. At "B" of each of the three claims, applicant claims an Internet server computer respectively *comprising a business card, a coupon and a greeting card*. Since examiner did not find a special "clear definition" for these three terms in the specification, the examiner is required to give the terms their broadest reasonable interpretation (MPEP § 2111), which the examiner judges to include *paper* business cards, coupons and greeting cards. Hence applicant is claiming an Internet server computer that comprises (*includes or is made up of*, Merriam-Webster Collegiate Dictionary) paper business cards, coupons and greeting cards. The rejection means that the specification does not describe how to make a server that includes or is made up of pieces of paper.
10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
11. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. The first line of each claim begins with "Internet promotion redemption (10) comprising an Internet server computer". First, it is not clear what the "(10)" refers to; numbers elsewhere in parentheses refer to figure numbers, but no number "10" was found in any of the figures. Second, "redemption" is a process or instance of redeeming, but the claim is to a redemption that comprises (*includes or is made up of*) a computer. A process is comprised of steps or other actions, and cannot be comprised of any thing other than steps or other actions. Similarly, an instance of redeeming cannot include or be made up of a computer or anything else tangible.
13. **Discussion:** In order to enable examination of the application, the examiner has assumed the following change to the first line of each claim, where underlines denote additions and braces "[]" denote deletions: "An Internet promotion redemption system comprising: A) An

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[an] Internet server computer". In addition, the examiner has assumed deletion of the "A)" appearing at the beginning of line 4 in each of the three claims. Examiner has then assumed that each embodiment of the invention is an Internet promotion redemption system comprising three components A), B) and C).

14. These are ad hoc assumptions done merely to enable examination of the claims on their merits. The claims remain of record as submitted by applicant, and the above rejections under 35 U.S.C. 112 remain until such time that they can be overcome by applicant's amendment or explanation. To be responsive and effective, any amendment submitted by applicant must show how the amendment is supported by the specification. Any amendment not supported is subject to rejection under the first paragraph of 35 U.S.C. 112 as new matter.

Claim Rejections - 35 USC § 102 and 35 USC § 103

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over Schena et al.
18. Schena et al. teaches an Internet promotion redemption system comprising: A) a *portal server* **200** [0027] which reads on an Internet server having an operating system, Internet connection means, CPU and motherboard, and data storage [0017] of the identification code

and promotion information [0031]; B) a business card with identification code [para. 0017] and promotion (*benefit redemption*, para. [0031] and [0042]), which reads on a coupon; and capability to perform all the steps C). (**Note:** Since these are system or apparatus claims, they can be patented only if *structurally* distinct from the prior art. They cannot be made patentable by the addition of steps or other *functional language*. See MPEP § 2114.)

19. Schena et al. does not explicitly teach business card indicia. However, since the structure recited in the reference is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that that it is these indicia that identify a business card as such.
20. Claim 3 is rejected under 35 U.S.C. 103(a) as obvious over Schena et al. in view of Moen et al. Schena et al. does not teach a greeting card. Moen et al. teaches a greeting card (col. 11-12, example 7). Because Schena et al. teaches that the reference invention is applicable to a broad variety of printed media for promotional purposes [0042] and Moen et al. teaches the greeting card for promotional purposes, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Moen et al. to those of Schena et al.

Special Note for Applicant Pro se

21. In this Office action the examiner has judged the claims on their face (*prima facie*) to be non-patentable. If applicant disagrees with the examiner's judgment, applicant should respond by filing arguments explaining, as precisely as possible, where the rejections in para. 7-20 above are wrong. In doing so applicant should recognize that the entire reference is available to support the rejection, not just the sections cited above by the examiner. Applicant should also recognize that MPEP § 2111 and 2111.01 require the examiner to give claims language its "broadest reasonable interpretation" unless applicant has provided a "clear definition" of the terms in the specification. Hence, if applicant believes the examiner's implicit interpretation is wrong, applicant should explain where a "clear definition" of the term(s) appears in the specification.
22. Applicant may also amend the claims to overcome the rejection. Applicant can do so in the current application only if the amending matter is presented in the current application. A

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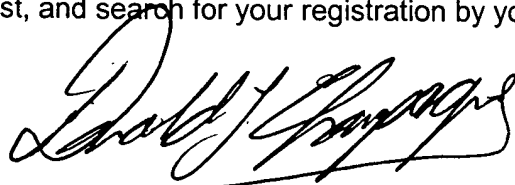
“new matter” rejection will result if the examiner cannot find the material in the specification. Hence, it is to applicant's advantage to applicant to point out in the reply where in the disclosure the amending material appears.

Conclusion

23. **COPY of REFERENCES** - Applicant is entitled to receive a copy of every reference cited by the examiner (except at allowance; MPEP 707.05(a)). Applicant should contact the examiner if a completed form PTO-892 is enclosed, but the cited references are not.
24. The references made of record and not relied upon are considered pertinent to applicant's disclosure. “Cable & Wireless” teaches the addition of promotion vendor information to an ordinary business card.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
26. **INTERVIEW** – Applicant would be welcome to discuss the application with the examiner in an “interview” (by telephone or in person, as applicant chooses). This is often especially helpful to discuss options applicant is considering for replying to the rejection. To do so, applicant should contact the examiner to schedule a date and time.
27. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last

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Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
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31 May 2003

It appears that the applicant in this application is a *pro se* applicant (an inventor filing the application alone without the benefit of a Patent Attorney or Agent). Applicant may not be aware of the preferred methods of ensuring timely filing of responses to communications from the Office and may wish to consider using the Certificate of Mailing or the Certificate of Transmission procedures outlined below.

CERTIFICATE OF MAILING

To ensure that the Applicant's mailed response is considered timely filed, it is advisable to include a "certificate of mailing" on at least one page (preferably on the first page) of the response. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on (date).

(Typed or printed name of the person signing this certificate)

(signature)

CERTIFICATE OF TRANSMISSION

Alternatively, if applicant wishes to respond by facsimile rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This method should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)____-____ on (date).

(Typed or printed name of the person signing this certificate)

(signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed. They must be signed, and the date must be the actual date on which it is mailed or transmitted.

For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, applicant's submission of a copy of the previously mailed or transmitted correspondence showing the **originally** signed Certificate of Mailing or Transmission statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmitting of the correspondence, would be sufficient evidence to entitle the applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing or Transmission, respectively.

NOTICE TO APPLICANT: In the case of lost or late responses the use of other "receipt producing" forms of mailing a correspondence to the Patent Office, such as Certified Mail, or a private shipper such as FedEx, **WILL NOT** result in the applicant getting the benefit of the mailing date on such receipts. These receipts are not considered to be acceptable evidence since there is nothing to "tie-in" the receipt with the particular document allegedly submitted.